



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/544,192

08/02/2005

Noriyuki Kikuchi

285-05

8340

7590

01/30/2008

John F McNulty
Paul & Paul
2900 Two Thousand Market Street
Philadelphia, PA 19103

EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

01/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/544,192

Applicant(s)

KIKUCHI, NORIYUKI

Examiner

Erica E. Cadugan

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

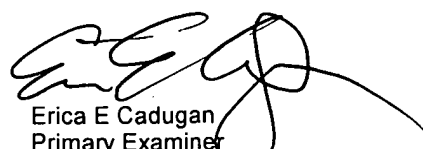
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Erica E Cadugan
Primary Examiner
Art Unit: 3722

Continuation of 3. NOTE: At least the new limitations in claim 1 ("said pallet defining a vertical surface for fixing a workpiece, so that said workpiece which is fixed on said pallet vertical surface, said pallet vertical surface, and said table or pallet mount are positioned in front of said spindle along said horizontal axis, in this order from said spindle...") raises new issues that would require at least further consideration and that would possibly require further search, noting that no such limitation has heretofore been presented.

Additionally, regarding the rejection under 35 USC 102(f) of claims 1-2 over US Patent Application Publication 2006/0260907 to Ota (which is the published version of 10/541430, which has no common inventor with the present application and which has a common assignee with the present application), Applicant has made a number of remarks/assertions.

Firstly, it is noted that Applicant filed a new Terminal Disclaimer (which incidentally was unnecessary as the one previously filed on August 9, 2007 was approved to overcome the previous obviousness-type double patenting rejections, as was indicated in the final rejection mailed October 15, 2007), apparently in an attempt to overcome the rejection under 35 USC 102(f) by including a statement that the two inventions were commonly owned or assigned at the time the claimed invention was made. However, as also indicated in the final rejection mailed Oct. 15, 2007, such a statement would *only* serve to preclude a rejection based on the Ota reference that was based on 35 USC 103(c), and would not in any way preclude the Ota reference from being applied under 35 USC 102(f). Applicant notes, correctly, that no 103 rejection based on Ota is at issue. However, again, such statement is not relevant re the pending 102(f) rejection.

Applicant further asserts that one reason for Applicant's traversal of the 102(f) rejection is that "[T]he presently claimed invention by applicant is a different invention from the invention claimed by Ota. Applicant claims "A pallet changer...". The reference Ota claims "A machine tool facility..." However, what Ota "claims" is irrelevant to the determination of whether Ota teaches the presently-claimed invention for the purposes of 102(f). (Note that the issue is a 102(f) rejection, and that the double patenting issue has already been settled with the terminal disclaimer filed in August of 2007). As set forth in the final rejection, Ota discloses each claim limitation of the present claims.

Applicant asserts that another reason for the traversal of the 102(f) rejection is that "Both inventions are owned by the same entity..." Again, common ownership does not preclude a rejection under 102(f). See at least MPEP section 706.02(l)(1), as outlined on page 10 of the final rejection.

Applicant additionally asserts that another reason for the traversal of the 102(f) rejection is that "Both patent applications to applicant's invention and to the Ota invention have the same priority date of December 3, 2004", and that "Both priority dates arise from International Applications filed in the Japanese Receiving Office on the same day." Applicant further states that "There is no evidence to substantiate that the Ota invention was 'made' under U.S. Patent Law before applicant's invention was made. Likewise there is no evidence that applicant's invention was made before the Ota invention. Therefore, each application is precluded from being used as a reference against the other."

However, this is not persuasive. As outlined in at least MPEP section 2137, "35 U.S.C. 102(f) does not require an inquiry into the relative dates of a reference and the application, and therefore may be applicable where subsections (a) and (e) are not available for references having an effective date subsequent to the effective date of the application being examined". Note that 35 USC 102(f) states that "A person shall be entitled to a patent unless he did not himself invent the subject matter sought to be patented", and that the Ota publication teaches all aspects of the presently-claimed invention and has NO COMMON INVENTOR with the present application.